

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:  
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PCT

WRITTEN OPINION

(PCT Rule 66)

Date of Mailing  
(day/month/year)

26 JUN 2001

Applicant's or agent's file reference  20101.002WO		REPLY DUE  within 2 months/days from the above date of mailing
International application No.  PCT/US00/26285	International filing date (day/month/year)  22 September 2000 (22.09.2000)	Priority date (day/month/year)  24 September 1999 (24.09.1999)
International Patent Classification (IPC) or both national classification and IPC  IPC(7): G06F 17/60 and US Cl.: 705/2		
Applicant  MARTIN, PAMELA R.		

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
  - I  Basis of the opinion
  - II  Priority
  - III  Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
  - IV  Lack of unity of invention
  - V  Reasoned statement under Rule 66.2 (a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
  - VI  Certain documents cited
  - VII  Certain defects in the international application
  - VIII  Certain observations on the international application
3. The applicant is hereby **invited to reply** to this opinion.
 

**When?** See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension. See rule 66.2(d).

**How?** By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

**Also** For an additional opportunity to submit amendments, see Rule 66.4. For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis. For an informal communication with the examiner, see Rule 66.6

**If no reply is filed,** the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 24 January 2002 (24.01.2002).

Name and mailing address of the IPEA/US  Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230	Authorized officer  Tariq Hafiz <i>Perry Hanool</i> Telephone No. 703.305.3900
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**I. Basis of the opinion**

## 1. With regard to the elements of the international application:\*

 the international application as originally filed the description:

pages 1-10, as originally filed

pages NONE, filed with the demand

pages NONE, filed with the letter of \_\_\_\_\_

 the claims:

pages 11 and 12, as originally filed

pages NONE, as amended (together with any statement) under Article 19

pages NONE, filed with the demand

pages NONE, filed with the letter of \_\_\_\_\_

 the drawings:

pages 1, as originally filed

pages NONE, filed with the demand

pages NONE, filed with the letter of \_\_\_\_\_

 the sequence listing part of the description:

pages NONE, as originally filed

pages NONE, filed with the demand

pages NONE, filed with the letter of \_\_\_\_\_

## 2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

 the language of a translation furnished for the purposes of international search (under Rule 23.1(b)). the language of publication of the international application (under Rule 48.3(b)). the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

## 3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the written opinion was drawn on the basis of the sequence listing:

 contained in the international application in printed form. filed together with the international application in computer readable form. furnished subsequently to this Authority in written form. furnished subsequently to this Authority in computer readable form. The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished. The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.4.  The amendments have resulted in the cancellation of: the description, pages NONE \_\_\_\_\_ the claims, Nos. NONE \_\_\_\_\_ the drawings, sheets/fig NONE \_\_\_\_\_5.  This opinion has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed."

**WRITTEN OPINION**International application No.  
PCT/US00/26283**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. STATEMENT**

Novelty (N)	Claims <u>NONE</u>	YES
	Claims <u>1-17</u>	NO
Inventive Step (IS)	Claims <u>1-17</u>	YES
	Claims <u>NONE</u>	NO
Industrial Applicability (IA)	Claims <u>1-17</u>	YES
	Claims <u>NONE</u>	NO

**2. CITATIONS AND EXPLANATIONS**

Please See Continuation Sheet

**Supplemental Box**  
(To be used when the space in any of the preceding boxes is not sufficient)**TIME LIMIT:**

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.

**V. 2. Citations and Explanations:**

Claims 1-17 lack an inventive step under PCT Article 33(3) as being obvious over the Prudential Health Care Plan of the Mid-Atlantic (1993).

The examiner has interpreted a central clearinghouse to include the administrators of health care plans, particularly managed care plans such as HMO's and certain PPO's. The specification defines a central clearinghouse as administering the financial aspects of the system. Specification, pg. 5. While it is noted that Applicant states that it is an objective of the invention to "provide a system for the payment of professional services that is not an insurance product," and to "provide a system for the payment of professional services outside of the current insurance system," applicant's claims define an insurance system and provide no differentiation. Specification, pg. 4.

As to claims 1 and 13, the Prudential Health Care Plan of the Mid-Atlantic teaches a system for the payment of fees (the Plan) comprising:

- a. service providers (Facts About Prudential Health Care Plan - specific physicians, hospitals, specialty doctors - pg. 6; Non-FEHB benefits available to Plan members - dental, vision, fitness - pg. 17);
- b. service receivers (Facts About Prudential Health Care Plan - you and your family - pg. 6); and
- c. a clearinghouse (Facts About Prudential Health Care Plan - the Plan - pg. 6),

wherein, the service providers subscribe with the clearinghouse to provide services to the service receivers, the service receivers subscribe with the clearinghouse to receive services from the service providers, the clearinghouse collects plan fees from the service receivers and distributes at least a portion of the plan fees to the service providers as payment fees, and the service receivers receive services from the service provider (Facts About Prudential Health Care Plan - "you are joining an organized system of health care that arranges in advance with specific physicians and hospitals to give care to members and pays them directly for their services" - pg. 6).

As to claims 2 and 14, the Prudential Health Care Plan of the Mid-Atlantic teaches that there is a bi-weekly premium collected, i.e. plan fees are collected on a set periodical basis for a set period of time (Chart - pg. 1).

As to claim 6, the Prudential Health Care Plan of the Mid-Atlantic teaches that "you pay a \$5 primary care office visit copay; a \$10 copay for specialty care office visits." (Medical and Surgical Benefits - pg. 10).

As to claim 7, the Prudential Health Care Plan of the Mid-Atlantic teaches that "each member must make ... [a] ... selection of a primary care doctor." (Role of a primary care doctor - pg. 6).

As to claim 8, the Prudential Health Care Plan of the Mid-Atlantic teaches that "you pay a ... \$10 copay for specialty care office visits," i.e. if the services receiver is provided services from a service provider not designated as the primary service provider, the service receiver pays to the non-primary service provider a service fee.

As to claim 9, the Prudential Health Care Plan of the Mid-Atlantic teaches that "covered benefits are available only from Plan providers except during a medical emergency" (Facts about Prudential Health Care Plan - pg. 6) and that care by non-Plan doctors or

**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

hospitals except for authorized referrals or emergencies are excluded (General Exclusions - pg. 9), i.e. the service receiver receives services from a service provider that is not subscribed to the clearinghouse, no fee is paid to the service provider by the clearinghouse and the service receiver is liable for the service provider's entire fee.

As to claim 12, traditional insurance coverage for prescription drugs, dental services and vision services are offered in combination with the services disclosed in Claim 1. (Prescription Drug Benefits - pg. 14, and Non-FEHB Benefits Available to Plan Members - pg. 17).

As to claims 3 and 15, the Prudential Health Care Plan of the Mid-Atlantic teaches all of the elements claimed with the exception of the clearing house distributing the payment fees to the service providers on a set periodical basis for a set period of time. The business practice of "distributing" or paying for multiple services on a monthly, biweekly or weekly basis is an old and well-established business practice. This practice is designed to increase the efficiency of processing payments, as well as reducing the number of checks or other negotiable instruments and thus, decreasing the overall paperwork. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a set periodical basis for a set period of time to distribute fees to the service providers to increase the efficiency of the payment regime.

As to claims 4-5 and 16, the Prudential Health Care Plan of the Mid-Atlantic teaches that "members must receive a referral from their primary care doctor before seeing any other doctor or obtaining special services"; that members "must return to the primary care doctor after consultation;" that "all follow-up care must be provided or authorized by the primary care doctor;" that "if additional services or visits are suggested by the consultant, members should first check with their primary care doctor;" and that one "does not go to the specialist unless your primary care doctor has arranged for and Plan has issued an authorization in advance," i.e. that the service providers provide a predetermined type or quantity of services to the service receivers. (Facts about Prudential Health Care Plan - pg. 7).

As to claims 10-11, the Prudential Health Care Plan of the Mid-Atlantic teaches that "members must receive a referral from their primary care doctor before seeing any other doctor or obtaining special services"; that members "must return to the primary care doctor after consultation;" that "all follow-up care must be provided or authorized by the primary care doctor;" that "if additional services or visits are suggested by the consultant, members should first check with their primary care doctor;" and that one "does not go to the specialist unless your primary care doctor has arranged for and Plan has issued an authorization in advance." (Facts about Prudential Health Care Plan - pg. 7).

Claim 17 is rejected for the same reason as set forth in claim 6.

Claims 1-6 and 9-11 lack an inventive step under PCT Article 33(3) as being obvious over Alec M. Schwartz, A Lawyer's Guide to Prepaid Legal Services, Legal Economics, July/August 1989, pp. 43-49.

As to claim 1, Schwartz teaches a system for the payment of legal fees (pg. 43 - title) comprising:

- a. service providers (Lawyers - "typical role for the private practitioner is that of legal service provider for plan members" - pg. 43);
- b. service receivers (Plan members - "typical role for the private practitioner is that of legal service provider for plan members" - pg. 43); and
- c. a clearinghouse (Legal Service Plan - "the consumer pays, or has paid in his or her behalf, from \$50 to \$200 a year to a legal service plan, in return for which he or she is eligible to use a lawyer for services which otherwise would cost hundreds or thousands of dollars" - pg. 43),

wherein, the service providers subscribe with the clearinghouse to provide services to the service receivers, the service receivers subscribe with the clearinghouse to receive services from the service providers, the clearinghouse collects plan fees from the service receivers and distributes at least a portion of the plan fees to the service providers as payment fees, and the service receivers receive services from the service provider (The Lawyers - "there is some sort of system which organizes lawyers into a contract service provider panel ... who agree to the terms and conditions under which the plan is operated" - pg. 46; Legal Service Plan - "the consumer pays, or has paid in his or her behalf, from \$50 to \$200 a year to a legal service plan, in return for which he or she is eligible to use a lawyer for services which otherwise would cost hundreds or thousands of dollars" - pg. 43; The Plan Administrator or Third Party - "handles plan finances, collects contributions, enrolls members, provides plan descriptions and forms to members, processes and pays claims and files reports required by regulatory agencies"- pg. 46).

As to claim 2, Schwartz teaches all of the elements claimed with the exception of the clearinghouse collecting plan fees from the service receivers on a set periodical basis for a set period of time. The business practice of having weekly, biweekly or monthly premium payments is an old and well-established business practice. This practice is designed to spread the payments out over a period of time thereby permitting consumers to afford to participate in a plan. It would have been obvious to one of ordinary skill in the art at the time of the invention to permit set periodical payments over a set period of time to maximize the potential enrollees and thus increase revenues.

As to claim 3, Schwartz teaches all of the elements claimed with the exception of the clearing house distributing the payment fees to the service providers on a set periodical basis for a set period of time. The business practice of "distributing" or paying for multiple services on a monthly, biweekly or weekly basis is an old and well-established business practice. This practice is designed to increase the efficiency of processing payments, as well as reducing the number of checks or other negotiable instruments and thus, decreasing the overall paperwork. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a set periodical basis for a set period of time to distribute fees to the service providers to increase the efficiency of the payment regime.

As to claims 4-5 and 10-11, Schwartz teaches that "benefits can be stated either in terms of the type of legal problems covered or the type of law service for which the plan will pay ... wills and estates ... may cover unlimited legal advice and consultation by telephone and pay up to a certain amount for services performed" and that "coverage limits may be specified either in

**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

terms of money or by stating the number of hours of attorney time for which the plan will pay. Alternatively, the benefit schedule may specify each service for which the plan will pay or provide, regardless of the cost or the time spent." (More Terminology: The Benefits and Exclusions - pp. 48-49).

As to claim 6, Schwartz teaches that "deductibles and copayments can be applied to some benefits." (More Terminology: The Benefits and Exclusions - pg. 49).

As to claim 9, Schwartz teaches that "exclusions are commonly used to limit coverage" (More Terminology: The Benefits and Exclusions - pg. 49;) and that there are closed panel plans which require that lawyers chosen by the plan must be used if consumers are to receive benefits under the plan (The Lawyers - pg. 46).

## PATENT COOPERATION TREATY

PCT

COPY

## INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 20101.002WO	<b>FOR FURTHER ACTION</b>	see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.
International application No. PCT/US00/26285	International filing date ( <i>day/month/year</i> ) 22 September 2000 (22.09.2000)	(Earliest) Priority Date ( <i>day/month/year</i> ) 24 September 1999 (24.09.1999)
Applicant MARTIN, PAMELA R.		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 3 sheets.



It is also accompanied by a copy of each prior art document cited in this report.

## 1. Basis of the Report

a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing:

contained in the international application in written form.

filed together with the international application in computer readable form.

furnished subsequently to this Authority in written form.

furnished subsequently to this Authority in computer readable form.

the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

2.  Certain claims were found unsearchable (See Box I).3.  Unity of invention is lacking (See Box II).

## 4. With regard to the title,

the text is approved as submitted by the applicant.

the text has been established by this Authority to read as follows:

## 5. With regard to the abstract,

the text is approved as submitted by the applicant.

the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

## 6. The figure of the drawings to be published with the abstract is Figure No. 1

as suggested by the applicant.

because the applicant failed to suggest a figure.

because this figure better characterizes the invention.



None of the figures

**Box III TEXT OF THE ABSTRACT (Continuation of Item 5 of the first sheet)**

The technical features mentioned in the abstract do not include a reference sign between parentheses (PCT Rule 8.1(d)).

**NEW ABSTRACT**

A system for the payment of fees having service providers Fig. 1 (14), service receivers (16), and a clearinghouse (12), in which the service providers (14) subscribe with the clearinghouse (12) to provide services to the service receivers (16), the service receivers (16) subscribe with the clearinghouse (12) to receive services from the service providers (14), the clearinghouse (12) collects plan fees from the service receivers (16) and distributes at least a portion of the plan fees to the service providers (14) as payment fees, and the service receivers (16) receive services from the service providers (14).

# INTERNATIONAL SEARCH REPORT

International application No.

PCT/US00/26285

## A. CLASSIFICATION OF SUBJECT MATTER

IPC(7) : G06F 17/60  
US CL : 705/2

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)  
U.S. : 705/2

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)  
Diaglog, East

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	Prudential Health Care Plan of the Mid-Atlantic, 1993, pages 1-20, especially 6-8 and 17.	1-2, 6-11, 13-14
---		-----
Y		3-5, 15-17
X	The 1994-95 Group Insurance Program for IEEE Members, pages 15-29.	1-2, 6-14
---		-----
Y		3-5, 15-17
Y	US 5,235,507 A (SACKLER et al.) 10 August 1993 (10.08.1993). Abstract, columns 1-4, especially column 1, lines 50-58.	1-17

Further documents are listed in the continuation of Box C.

See patent family annex.

• Special categories of cited documents:	"T"	later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"A" document defining the general state of the art which is not considered to be of particular relevance	"X"	document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"E" earlier application or patent published on or after the international filing date	"Y"	document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"&"	document member of the same patent family
"O" document referring to an oral disclosure, use, exhibition or other means		
"P" document published prior to the international filing date but later than the priority date claimed		

Date of the actual completion of the international search

04 December 2000 (04.12.2000)

Date of mailing of the international search report

09 JAN 2001

Name and mailing address of the ISA/US

Commissioner of Patents and Trademarks  
Box PCT  
Washington, D.C. 20251

Faxsimile No. (703)305-3230

Authorized officer

Tariq Hafiz

Telephone No. 703.305.3900

*Peggy Harrod*

## PATENT COOPERATION TREATY

PCT

14

REC'D 29 OCT 2001	
WIPO	PCT

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

## (PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>20101.002WO</b>	FOR FURTHER ACTION	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)
International application No. <b>PCT/US00/26285</b>	International filing date (day/month/year) <b>22 September 2000 (22.09.2000)</b>	Priority date (day/month/year) <b>24 September 1999 (24.09.1999)</b>
International Patent Classification (IPC) or national classification and IPC <b>IPC(7): G06F 17/60 and US Cl.: 705/2</b>		
Applicant <b>MARTIN, PAMELA R.</b>		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of    sheets.

3. This report contains indications relating to the following items:

- I  Basis of the report
- II  Priority
- III  Non-establishment of report with regard to novelty, inventive step and industrial applicability
- IV  Lack of unity of invention
- V  Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI  Certain documents cited
- VII  Certain defects in the international application
- VIII  Certain observations on the international application

Date of submission of the demand <b>24 May 2001 (24.05.2001)</b>	Date of completion of this report <b>25 September 2001 (25.09.2001)</b>
Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230	Authorized officer Tariq Hafiz <i>James R. Matties</i> Telephone No. 703.305.3900

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US00/26285

**I. Basis of the report**

## 1. With regard to the elements of the international application:\*



the international application as originally filed.



the description:

pages 1-10 as originally filed

pages NONE, filed with the demandpages NONE, filed with the letter of \_\_\_\_\_

the claims:

pages 11 and 12, as originally filed

pages NONE, as amended (together with any statement) under Article 19pages NONE, filed with the demandpages NONE, filed with the letter of \_\_\_\_\_

the drawings:

pages 1, as originally filed

pages NONE, filed with the demandpages NONE, filed with the letter of \_\_\_\_\_

the sequence listing part of the description:

pages NONE, as originally filedpages NONE, filed with the demandpages NONE, filed with the letter of \_\_\_\_\_

## 2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:



the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).



the language of publication of the international application (under Rule 48.3(b)).



the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

## 3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:



contained in the international application in printed form.



filed together with the international application in computer readable form.



furnished subsequently to this Authority in written form.



furnished subsequently to this Authority in computer readable form.



The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.



The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4.  The amendments have resulted in the cancellation of:
 the description, pages NONE
 the claims, Nos. NONE
 the drawings, sheets/fig NONE


This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

\*\* Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

**INTERNATIONAL PRELIMINARY EXAMINATION REPORT**International application No.  
PCT/US00/26285**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. STATEMENT**

Novelty (N)                      Claims 1-17                      YES  
                                      Claims NONE                      NO

Inventive Step (IS)              Claims NONE                      YES  
                                      Claims 1-17                      NO

Industrial Applicability (IA)    Claims 1-17                      YES  
                                      Claims NONE                      NO

**2. CITATIONS AND EXPLANATIONS**

Please See Continuation Sheet